

REMARKS

Reconsideration and allowance of the above-identified application are respectfully requested. Upon entry of the foregoing amendments, claims 8-15 and 20-27 will be pending. By way of the foregoing amendments new claims 23 - 27 have been added.

Claims 8-11, 16-18 and 21 were rejected prior to the filing of the accompanying request for continued examination (RCE) under 35 U.S.C §103(a) as being allegedly unpatentable over Thompson et al. (U.S. Patent Number 6,484,011 B1) in further view of Williams et al. (U.S. Patent Number 5,977,964). By way of the foregoing amendments, claims 16-18 have been cancelled rendering this ground of rejection moot with respect thereto and to the claims which previously depended therefrom. Accordingly, the following comments relate only to independent claim 8 and the claims which depend therefrom.

The arguments previously presented by Applicant in the Amendment After Final filed on March 30, 2005, and the Examiner's responses thereto, are discussed below in two sections: (1) regarding the motivation (or lack thereof) to combine Thompson and Williams in the manner needed to have arrived at Applicant's claimed combinations and (2) whether, even if combined, Applicant's claim combination would have resulted from any mixture of the teachings of Thompson and Williams. Applicant respectfully requests that the Examiner reconsider these issues in light of the following arguments as part of processing the RCE.

Motivation to Combine

The Official Action of January 26, 2005 correctly states that the "Thompson et al. reference discloses receiving selected information at the remote control device

(Thompson 5:48-55)" and that "the Thompson et al. reference is silent as to wherein the output device is for providing an alert to a user when a scheduled event occurs."

To remedy the recognized deficiencies of Thompson et al., the Official Action relies on Williams et al., specifically, the Official Action states that:

"providing an alert to a user when a scheduled event occurs is met by in an alternate embodiment, system controller 104 may provide programming suggestions to a user well in advance (e.g., a couple of days or weeks), with options for issuing reminder prompts, to record the program, or to forego further prompts of the program (Williams et al. 12:36-40)."

Regarding motivation to combine, the Official Action notes that "the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Thompson et al. data displayed on remote control device with the Williams et al. reminder prompts for the purpose of alerting a user of program events during periods when a television display is in an off state" (emphasis added). As previously stated in the Amendment After Final, the undersigned respectfully submits that this statement of motivation must be considered impermissible hindsight reference to Applicant's own specification because Williams is only concerned with providing prompts to a user when the system is on, as implied by Williams' provision of prompts via interactive pop-up windows (see col. 11, lines 49-53). Thus, the statement made in the Official Action regarding operation of the system described in Williams when a television is in an off-state is pure speculation used to fill a void in the teachings of the applied documents.

In response to the above-comments in the Amendment After Final, the Examiner noted as follows:

"However, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re*

McLaughlin, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In the instant case, it is knowledge which was within the level of ordinary skill at the time the claimed invention was made that information may be conveyed on a remote control even during times that the television display is in an off state.”

Applicant respectfully submits that where it is necessary to modify a secondary reference (Williams) that is, itself, being used to modify a primary reference (Thompson) in order to find a motivation to reach Applicant’s claimed combinations, that such a modification is more properly considered impermissible hindsight than the permissible hindsight referred to in the *McLaughlin* case. In this instance, the use of knowledge attributable to one of ordinary skill in the art is used as the glue not only to make the combination, but to modify the combination of the actual teachings of the cited references. Applicant respectfully submits that such a rejection does not constitute a *prima facie* case of obviousness pursuant to 35 U.S.C. §103.

Resulting Combination

Applicant notes that the Examiner dismissed Applicant’s argument that the resulting combination of Thompson and Williams, even if not the product of impermissible hindsight, would still not have resulted in Applicant’s claim 8 combination. Specifically, the Advisory Action states that:

“the features upon which applicant relies (i.e., a remote control device including an output device in communication with the processor, wherein the output device is for providing an alert to a user when a scheduled event occurs) are not recited in the rejected claim(s).”

Applicant respectfully disagrees with this statement, because this language “the remote control device including an output device in communication with the processor, wherein the output device is for providing an alert to a user when a scheduled event occurs” is in fact part of Claim 8. Accordingly, reconsideration of

this argument by the Examiner is respectfully requested.

New Claims

New claims 23-27 have been added by way of this response in order to provide additional claim coverage for the present invention. More specifically, claim 23 refers to an exemplary embodiment of the present invention wherein a remote control device includes: a processor; a remote control receiver in communication with the processor, wherein the remote control receiver is for receiving data from an electronic program guide, wherein the data indicates the occurrence of a scheduled event; an input device in communication with the processor; a data storage area in communication with the process; and an output device in communication with the processor, wherein after the processor retrieves instructions from the data storage area, interprets the data based upon the retrieved instructions and controls the output device to produce a customized alert associated with said scheduled event. This combination of features is not taught nor suggested by any of the cited documents whether taken singly or in combination.

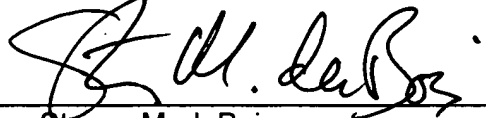
Independent claim 26 refers to an exemplary embodiment of the present invention where a system includes: a remote control device, the remote control device including: a processor, a remote control receiver in communication with the processor; an input device in communication with the processor; a light source in communication with the processor; a storage area in communication with the processor; a motion detector in communication with the processor, wherein the processor can retrieve instructions from the storage area and then sends a signal to a light source to illuminate a portion of the input device; and an output device in communication with the processor, wherein the output device is for providing an alert

to a user when a scheduled event occurs; and an electronic device, the electronic device including: a receiver for receiving signals from the remote control device; an electronic program guide; and a transmitter in communication with the electronic program guide, the transmitter for transmitting data from the electronic program guide to the remote control device, wherein the data indicates an occurrence of the scheduled event. This combination of features is not taught nor suggested by any of the cited documents whether taken singly or in combination.

All of the objections and rejections raised in the Office Action having been addressed, it is respectfully submitted that this application is in condition for allowance and a notice to that effect is earnestly solicited. Should the Examiner have any questions regarding this response or the application in general, he is invited to contact the undersigned at (540) 361-1863.

Respectfully submitted,

POTOMAC PATENT GROUP PLLC

By: 
Steven M. duBois
Registration No. 35,023

Date: June 27, 2005

Potomac Patent Group, PLLC
P.O. Box 270
Fredericksburg, VA 22404
(540) 361-1863